

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 13

HRW

8/17/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re FORMTEK, Inc.

Serial No. 75/310,027

Keiichiro Imai for FORMTEK, Inc.

Nicholas K. D. Altree, Trademark Examining Attorney, Law
Office 109 (Ronald R. Sussman, Managing Attorney).

Before Hohein, Wendel and Bottorff, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Formtek, Inc. has filed an application to register the
mark FORMTEK ORION for "computer software for enterprise
information management enabling users across an entire
enterprise to store, access, distribute, and manage all
types of information."¹

Registration of applicant's mark has been finally
refused under Section 2(d) of the Trademark Act, 15 U.S.C.

¹ Serial No. 75/310,027, filed June 16, 1997, claiming a first
use date and a first use in commerce date of October 31, 1996.

§ 1052(d), on the ground of likelihood of confusion with the mark depicted below, which is registered for "computer software in the field of database management."²

The refusal has been appealed and both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

We make our determination of likelihood of confusion on the basis of those of the *du Pont* factors³ which are relevant under the circumstances at hand. Two key considerations in our analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods in connection with which the marks are being used. See *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Insofar as the marks are concerned, the Examining Attorney argues that this is a situation in which the general rule that the addition of a house mark to one of

² Registration No. 1,671,609, issued January 14, 1992.

³ *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

two otherwise confusingly similar marks cannot avoid a likelihood of confusion is applicable. Here, he asserts, applicant is using FORMTEK as a house mark in conjunction with the product mark ORION. He argues that the term ORION is the dominant portion of registrant's product mark and that the term ORION is arbitrary, and thus of a relatively high degree of trademark significance, when used in connection with software goods. He takes the position that applicant "cannot justify its confusing use of a senior user's mark by simply tacking on its own house mark."

Applicant, on the other hand, contends that when the marks are considered in their entirety, there are clear differences in appearance and sound. Although acknowledging that the term ORION has the same connotation in both marks, applicant argues that the overall commercial impressions created by the marks are different. Applicant asserts that the cited mark is only a product mark, whereas applicant's mark is a combination of a product mark and its house mark FORMTEK, the significance of which would be readily apparent.⁴

⁴ As noted by the Examining Attorney, applicant is the owner of Registration No. 1,863,587 for the mark FORMTEK for "computer programs for database management."

As for the general rule with respect to the addition of a house mark to another mark, applicant points out that there are exceptions to the rule and argues that the exception made when there are recognizable differences between the marks should be applicable here. In addition, applicant notes the results of an on-line trademark search which it has made of record in which thirty-seven "hits" were obtained in the U. S. Federal database for marks containing the term ORION, either alone or in combination with other symbols, for use in connection with computer software. Applicant contends that these results demonstrate that registrant's mark is "weak" and that, as a result, applicant's addition of a house mark to the term is sufficient to negate the likelihood of confusion.

As a general rule, the addition of a house mark to one of two otherwise confusingly similar marks will not serve to avoid a likelihood of confusion. See *In re Apparel Ventures, Inc.*, 229 USPQ 225 (TTAB 1986); *In re Christian Dior, S.A.*, 225 USPQ 533 (TTAB 1985); *In re C.F. Hathaway Co.*, 190 USPQ 343 (TTAB 1976). In fact, the addition may actually be an aggravation of the likelihood of confusion, rather than a distinguishing factor. Exceptions are made to this general rule, however, if (1) there are some recognizable differences in the conflicting product marks,

or if (2) the product marks are merely descriptive or highly suggestive or play upon commonly used or registered terms, so that the addition of the house mark may be sufficient to render the marks as a whole distinguishable. See *In re Christian Dior, S.A.*, *supra*, and the case cited therein.

Here the product marks in question are registrant's mark ORION and accompanying star design and applicant's mark ORION. We agree with the Examining Attorney that it is the word portion ORION which dominates registrant's mark and which would be more likely to be remembered and relied upon by purchasers in referring to the goods. Thus, it is the word portion ORION which will be accorded more weight in determining the similarity of the marks. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987).

As such, we find the conflicting product marks to be without recognizable differences. Although applicant strongly contends that there are such differences, its arguments appear to be based on the additional presence of the house mark in its composite mark. The comparison, however, must be made between the product marks alone. The only difference is the star design is registrant's mark, which we find of minimal significance in the overall commercial impression created by the mark. Furthermore, as

pointed out by the Examining Attorney, since applicant's mark is in typed form, applicant is free to adopt any reasonable display of its mark, including one identical to that of registrant's.⁵ Accordingly, the first exception is not applicable here.

Turning to the second exception, applicant has made no argument that the term ORION is either merely descriptive or highly suggestive when used in connection with software products such as those involved here, nor would it appear that such an argument could be plausibly made. Instead, applicant argues that the registered mark is "weak," in view of the evidence which it has submitted which it claims shows third-party use of marks comprised of or containing the term ORION for software products.

In the first place, the mere existence of third-party registrations is not evidence of use of the marks or that customers are familiar with them. See *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 403, 177 USPQ 268 (CCPA 1973); *In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974). Moreover, upon a review of the search report from August 1998, we note that of the thirty-seven "hits" for federal registrations and applications, only nine were active

⁵ We note that on the specimens of record applicant uses a star design in connection with its house mark.

registrations at that time.⁶ The marks, which covered not only ORION alone but also ORION in connection with other words or designs, were registered for use with a variety of software products, many for highly specialized fields. On the whole, we find this evidence totally inadequate to establish that the term ORION is a "weak" mark when used in connection with the type of data and enterprise information management software which is involved here. Applicant has failed to show the product mark ORION is so commonly used or registered in the relevant field that the addition of its house mark would be sufficient to render the marks as a whole distinguishable. Thus, the second exception is also not applicable here.

Accordingly, we find the general rule controlling in the present situation, i.e., applicant's addition of its house mark FORMTEK to the product mark ORION is not sufficient to avoid a likelihood of confusion, when the marks are used on related software products.

In determining whether such a relationship exists between the software products involved here, we are guided by the general principle that it is not necessary that the goods of an applicant and registrant be similar or even

⁶ Upon checking Office records we find that certain of these nine registrations are now cancelled.

competitive in order to support a holding of a likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used therewith, give rise to the mistaken belief that they emanate, or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein.

The Examining Attorney maintains that applicant's goods are so broadly identified as "computer software for enterprise information management enabling users across an entire enterprise to store, access, distribute, and manage all types of information" as to encompass the "database management" provided by registrant's software. As support for this conclusion, the Examining Attorney points to a statement made by applicant's counsel that "[a]pplicant's software includes database management, but it provides other features such as... ." (Response July 27, 1998, p. 4). The Examining Attorney also relies upon descriptions of the data management functions of applicant's software found in materials submitted by applicant together with computer dictionary definitions of "data management" and

"DBMS" ("DataBase Management System")⁷ as evidence that the database management of registrant's software is a subset falling within the data management functions of applicant's enterprise information management software.

Applicant argues that database management software is software that "organizes and provides ready access to information in a database" whereas applicant's software is an "application" software which "is used to perform various operations on information such as storing, accessing, distributing, and otherwise managing all kinds of information in an enterprise." (Request for Reconsideration, p. 4). Applicant argues that although most application software would include a database management function, there is a category distinction between database management software and application software and that purchasers would be aware of this distinction.

As previously noted, the question is not whether applicant's software and registrant's software are

⁷ The definitions relied upon from *The Computer Glossary* (1998) are:

data management (2) Software that allows for the creation, storage, retrieval and manipulation of files interactively at a terminal or personal computer. See *file manager* and *DBMS*.

DBMS (DataBase Management System) Software that controls the organization, storage, retrieval, security and integrity of data in a database.

identical or even competitive. They need not perform the same range of functions or even be classified in the same category. It is simply a question of whether a viable relationship exists between the respective software products such that the same purchasers might encounter both products and such that, because of the use of confusingly similar marks thereon, these purchasers might well assume that the products emanate from the same source. Here, we find the evidence of record sufficient to demonstrate that such a relationship exists between the products, regardless of the fact that the database management function of registrant's software may be but a portion of the enterprise information management provided by applicant's software.

Furthermore, since there are no restrictions in the identification of goods in the application or registration as to channels of trade, we must presume that the software of both applicant and registrant would travel in all the normal channels of trade for such goods and thus be encountered by the same purchasers. See *Kangol Ltd. v. KangaROOS U.S.A.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). We find it highly likely that these purchasers would believe that these two software products being offered under the same product name, ORION, originate from

the same source. Although the confusion may be of the reverse nature, in that purchasers may assume that applicant is the source of registrant's ORION software, a likelihood of confusion exists. Applicant's use of its house mark in connection with the product mark ORION merely serves to aggravate the likelihood of confusion with contemporaneous use of the ORION marks on the respective software products. See *In re Christian Dior, S.A.*, *supra*.

Applicant further argues that consideration must be given to the fact that the purchasers of these software products are sophisticated purchasers who would buy the products only after careful consideration. Applicant notes that its software is designed for large organizations and is relatively expensive, costing in the range of \$30,000 to \$200,000.

Although we agree that sophisticated purchasers are involved here, and that the goods are far from "impulse" items, we remain of the opinion that the addition of a house mark, in this case the designation FORMTEK, which applicant claims would be readily recognized, would lead to confusion on the part of these purchasers as to the source of the respective goods. It is sophisticated purchasers who would be most likely to be familiar with applicant's house mark and thus to make the mistaken assumption that

Ser No. 75/310,027

the goods of registrant also emanate from, or are associated with, applicant.

Accordingly, upon full consideration of the relevant *du Pont* factors, we find that contemporaneous use by applicant of its FORMTEK ORION mark and registrant of its ORION and design mark for their respective software products is likely to cause confusion.

Decision: The refusal to register under Section 2(d) is affirmed.

G. D. Hohein

H. R. Wendel

C. M. Bottorff

Administrative Trademark Judges,
Trademark Trial and Appeal Board

Ser No. 75/310,027